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IN THE
Supreme Court of the United States

OCTOBER TERM, 1945

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No. _____

MADGE MESSLER,

Petitioner,

v.

UNITED STATES RUBBER COMPANY,

Respondent.

**BRIEF OF RESPONDENT IN OPPOSITION
TO PETITION FOR CERTIORARI.**

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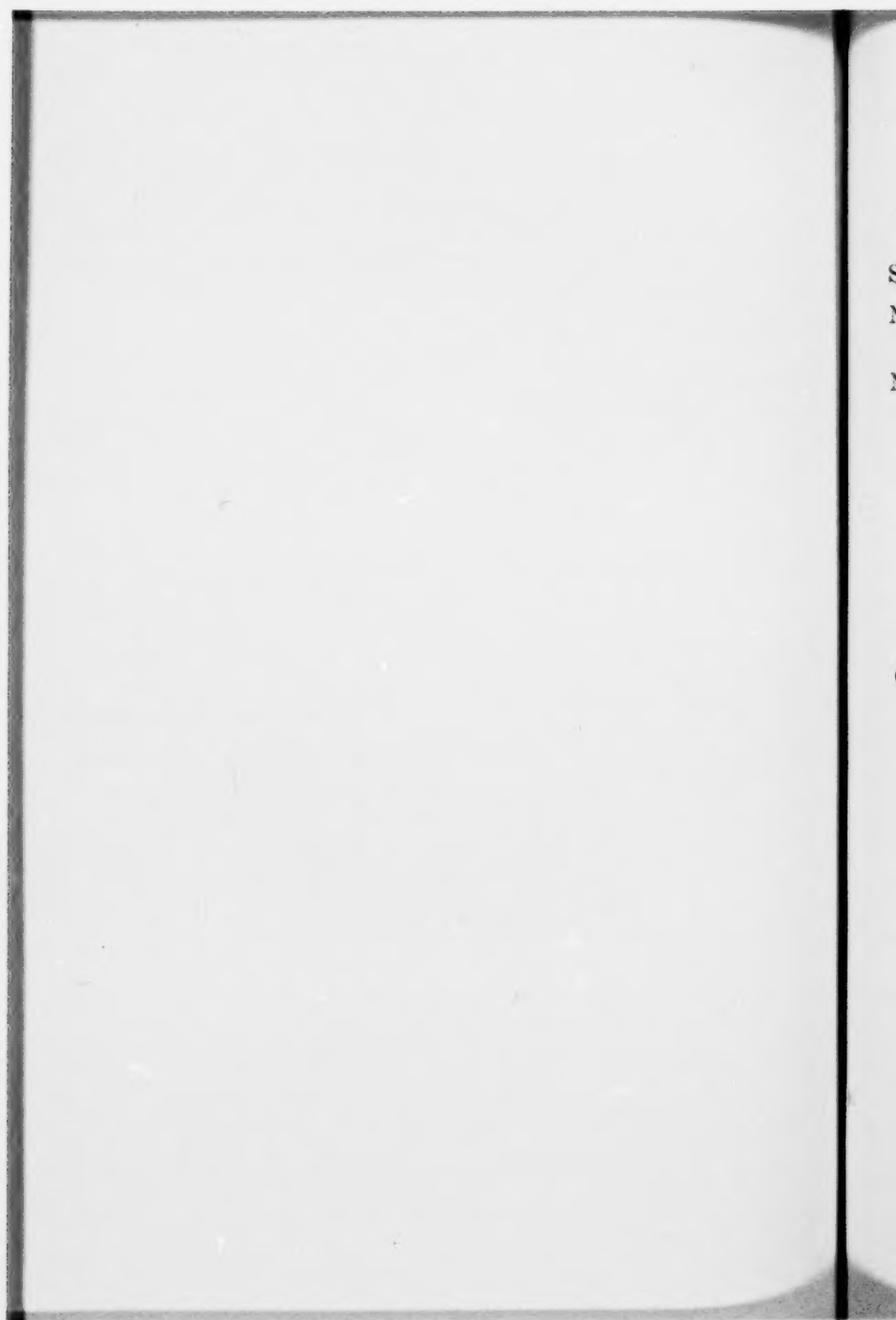


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**BRIEF OF RESPONDENT IN OPPOSITION
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Statement of the Case.

This is an ordinary patent case which has gone through the regular channels to the Court of Appeals to decision adverse to the Petitioner. Both lower courts held the Messler patent invalid and non-infringed upon substantially the same grounds. The concurrent holdings of the lower courts strongly indicate that no error has been made. The decision of the District Court was not reported. The decision of the Circuit Court of Appeals is as yet not reported except in 65 U. S. P. Q. 145.

**No Sufficient Grounds Are Alleged for Granting
the Petition.**

The Petitioner sets forth six grounds for review. The first five of these relate to the holding of invalidity and the sixth to the holding of non-infringement.

The first five points urged by the Petitioner for review are based upon the following portions of the decision of the Court of Appeals:

“The contention that the self-serving declarations of the affidavit filed in the Patent Office five years after Cort’s application should be given weight as evidence or should shift the burden of proof to the defendant is to say the least surprising. Under the rule of the Patent Office it served the purpose of securing an issue of the patent in suit in spite of the earlier disclosure by Cort. But the issue under such circumstances in no sense was the equivalent of an adjudication of priority, nor did it involve any exercise of discretion by the Patent Office, for the mere filing of the affidavit required the issue under the rule irrespective of any merits. * * *

The decisions we have referred to fail to persuade us that an ex parte affidavit of an inventor under Rule 75 is evidence which calls upon an allegedly infringing defendant to controvert the truth of the affidavit. * * *

Rule 75 is a rule of procedure established by the United States Patent Office under authority of Section 483 of the Revised Statutes (U. S. C., title 35, Sec. 10). Rule 75 is as follows:

“When an original or reissue application is rejected on reference to an expired or unexpired domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, and shall also make oath that he does not know and does not believe that the invention has been in public

use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than one year * prior to his application, and that he has never abandoned the invention, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year * prior to the date on which application was filed in this country."

Affidavits filed under the Rule are in prosecution of patent applications, which is an *ex parte* proceeding. The affiants are not subject to cross examination, as in *inter partes* cases. The affidavits are not even open to public inspection until after the patent has been granted. The public is not bound by such *ex parte* proceedings, but the patentees are. *Keystone Co. v. Phoenix Co.*, 95 U. S. 274, 279. In view of this situation it is clear that such affidavits are nothing more than self-serving declarations, and should not be given weight as evidence to shift the burden of proof to the defendant.

It is also clear from the language of Rule 75 that it sets forth an *ex parte* procedure leading merely to the *grant* of a patent. This can be in no sense the equivalent of an adjudication of priority.

The question of infringement is one of fact (*Winans v. Denmead* (56 U. S. 545, 551) (15 How. 330); *Coupe v. Royer*, 155 U. S. 565, 575).

Where both the District and Circuit Courts have concurred in their findings on such factual questions, they will not be disturbed by this Court except in cases of clear error. *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U. S. 405 (1908), at page 416; *Williams Mfg.*

"*In the case of applications for patent filed prior to August 5, 1940, this period is two years instead of one year."

Co. v. United Shoe Machinery Corporation, 316 U. S. 364 (1942), at page 367; *Goodyear Tire & Rubber Company v. Ray-O-Vac Co.*, 321 U. S. 275 (1944), at page 278; *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U. S. 471 (1944), at page 473. The petition shows no reviewable error in respect to these factual questions. Therefore, infringement should not be reviewed. Validity then becomes moot, as no controversy would exist between the parties. Such a case is not determinable by Federal Courts under Article 3, Section 2 of the Constitution, as interpreted by the following decisions:

Aetna Life Insurance Co. v. Haworth, 84 F. (2d) 695, (Certiorari granted 299 U. S. 536); and *Cover v. Schwartz*, 133 F. (2d) 541, (Certiorari denied 319 U. S. 748).

None of Petitioner's Cases Is Apposite.

None of the cases relied upon by Petitioner supports the ground for which cited, except the case of *Thacher v. Mayor*, 219 Fed. 909 (D. C. Md. affirmed 230 F. 1022), and that case is in direct conflict with *Thacher v. Board of Supervisors*, 235 Fed. 724 (D. C., S. D. Iowa, C. D.). Both the District Court and the Court of Appeals below disregarded the first case and followed the second. It appears also that *Thacher v. Mayor* has been overruled by *Milburn v. Davis*, 270 U. S. 390, as will be shown below.

Cases Under Petitioner's Ground 1:

The cases of *Deering v. Winona Harvester Works*, 155 U. S. 286, and *Pullman Palace Car Company v. Boston, etc., R. R.*, 44 F. 195 are cited by Petitioner in support of the point that the practice under Rule 75 is well established in the Patent Office and has received the sanction of the courts. There is no dispute as to this.

In the *Deering* case (p. 298) it appears that an English patent was cited as a prior reference against the application for the patent in suit and that the applicant filed an affidavit under Rule 75 which was accepted by the Patent Office to overcome the reference. In the infringement suit the Court did not rely upon the affidavit but upon evidence offered at the trial, such evidence including a model shown by witnesses to have been completed prior to the effective date of the British patent. This case refutes instead of supporting Petitioner.

In the *Pullman* case an affidavit was filed to overcome the prior filing date of a patent to Sessions. It is clear that in the infringement suit the Court did not rely upon the affidavit but upon the testimony of Sessions. The Court (p. 203) stated that:

"The ground taken by the patent-office in finally granting this (*Pullman*) patent does not appear, but it does appear by this record that Sessions swears that what *Pullman* said in his affidavit as to his invention was true in point of fact."

This case also refutes instead of supporting Petitioner.

In *Corona v. Dovan Corp.*, 276 U. S. 358, an affidavit under Rule 75 was filed, but the opinion clearly reveals that the affidavit was not relied upon by the Court in the infringement suit. Weiss, the inventor of the patent in suit, introduced extensive testimony and exhibits including laboratory notebooks and other data to establish as early a date as possible (pp. 376, 377). This case is cited in support of the statement that "The reasonable presumption of validity furnished by the grant of a patent on the basis of an affidavit under Rule 75 is not destroyed except by convincing evidence". There is no such statement in the opinion, nor can we find anything like it. In respect to "The reasonable presumption of validity furnished by the grant

of a patent" the Court said (p. 374) that it had not been shown that the patent in suit was obtained through false evidence or reckless statements made in affidavits filed under Rule 75.

The cases of *Miller v. Brass Company* and *Alvord v. Smith et al.* (p. 6 of Petitioner's brief) were cited in support of the point that when a patent does not claim an invention, it is either not the patentee's invention, or if it is, he thereby dedicates it to the public. That point is immaterial to any issue involved here. The present case comes squarely under the subsequently decided case of *Milburn v. Davis*, 270 U. S. 390.

Cases Under Petitioner's Ground 2:

The cases *Willamette-Hyster Co. v. Pacific Car & Foundry Co.*, 122 F. (2d) 492, and *Thacher v. Mayor*, 230 F. 1022 are cited as being in conflict with the decision of the Court below on the point that a patent which was overcome by an affidavit under Rule 75 is a valid reference.

In the *Willamette* case the suit was on a patent, in the course of prosecution of which an affidavit under Rule 75 was filed. It appears from the decision (p. 497) that the Court paid no attention to the affidavit under Rule 75, but on the other hand held the patent in suit invalid in view of a publication having an effective date more than two years prior to the filing date of the patent in suit. The foregoing shows that this decision of the 9th Circuit is not in conflict with the Court of Appeals in this case.

The case of *Thacher v. Mayor* appears to be in direct conflict with the decision below in this case. The decision in the *Thacher* case is unsound on elementary principles of law. It is so clearly out of line that it should be disregarded. Furthermore, the *Thacher* case was affirmed by

the Fourth Circuit Court of Appeals on February 2, 1916, which was prior to the decision in the *Milburn* case on March 8, 1926. Prior to the latter date, as stated in the *Milburn* decision (p. 399), there was a conflict in the Circuit Courts as to whether or not a patent disclosing, but not claiming, an invention and issuing upon an application co-pending with a later filed application was a reference against a patent in suit claiming the invention and issuing upon a later filed application. The *Milburn* case decided that the patent which issued on the earlier filed co-pending application was a reference. In view of this decision, the only way the patent in suit could be valid was by carrying the patentee's date of invention back of the earlier filing date of the reference patent. If this had been the law at the time *Thacher v. Mayor* was decided, obviously the Court would not have held that the affidavit under Rule 75 was alone sufficient to carry back the date of invention.

As to whether or not an affidavit under Rule 75 is sufficient alone to carry back the date of invention when not supported by other evidence, there is no conflict in the cases since *Milburn v. Davis*.

Cases Under Petitioner's Ground 3:

It is well known that the Patent Office makes no attempt to inquire into the truth or falsity of an affidavit under Rule 75, and therefore its decision on this point is in no sense an adjudication of priority. As already explained, the Court did not accept the affidavit under Rule 75 without supporting evidence to carry back the date of invention in the *Deering* case. The other cases cited under this Ground have no bearing on the issues involved.

Petitioner's Ground 4:

No cases are cited by Petitioner in support of Ground 4. As previously explained, once the applicant has complied

with the provisions of Rule 75, the affidavit is accepted without further exercise of discretion on the part of the Patent Office.

Cases Under Petitioner's Ground 5:

Petitioner again cites the *Corona* case under her Ground 5 in support of the proposition that when the validity of a patent hinges on a reference which has been overcome by an affidavit under Rule 75, the burden should be on the defendant. As previously pointed out herein, in the *Corona* case the patentee of the patent in suit did not rely upon the affidavit under Rule 75 but on the other hand called witnesses who submitted additional data to carry back the date of invention. So far as the opinion reveals, the affidavits were not relied upon to carry back the date of invention without the support of the additional evidence. There is nothing to show that the burden of proof shifted before the additional evidence was introduced.

Cases Under Petitioner's Ground 6:

The Petitioner has cited a number of cases in support of Ground 6 relating to the matter of infringement. There does not appear to be any doubt as to the proper interpretation of the scope of the claims of the patent in suit by the lower courts. It therefore appears that the decisions cited by the Petitioner are inapplicable, and as this question is one of fact, the concurrent findings by the lower courts should not be disturbed for reasons already pointed out (*supra*, p. 3).

Conclusion.

The Petitioner has not shown that this case involves any matter of important public interest, or that there is any conflict of opinion on the principles involved between dif-

ferent Circuit Courts of Appeal since the decision in the *Milburn* case, or that the decision of the Second Circuit Court of Appeals in this case is clearly erroneous. The factual question of infringement is decisive in the case and renders it wholly unnecessary for this Court to decide any other issues even if such issues were present in the case. For these reasons the petition should be denied.

Respectfully submitted,

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